

REMARKS

By the present amendment and response, independent claim 11 has been amended to overcome the Examiner's objection. Thus, claims 1-20 remain pending in the present application.

In the Office Action dated March 25, 2003, the Examiner has objected to claim 11, line 10, in that a period at the end of the sentence is shown and that there is a continuation of claim language after the period. By this amendment, applicant has amended claim 11 to remove the typographical error.

In page 2 of the Detailed Action, the Examiner has stated that the present application contains generic claims 1-4 while the remaining claims are directed to the following ten (10) "patentably distinct species":

Species I, claim 5

Species II, claim 6

Species III, claim 7

Species IV, claim 8

Species V, claims 9-10

Species VI, claims 11-16

Species VII, claim 17

Species VIII, claim 18

Species IX, claim 19

Species X, claim 20.

A. Applicant's Express Election and Traverse Under MPEP §818.03

For the purpose of being responsive to the Examiner's request in pages 2-3 of the Detailed Action, and as required by MPEP §809.02(a) and §818.03, applicant hereby elects, *with traverse*, Species VI containing claims 11-16, in addition to generic claims 1-4 for examination on the merits. At the outset, it is noted that according to MPEP §803, the two criteria for a proper requirement for restriction are that (1) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); and (2) There must be a serious burden on the examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02). As such, applicant *traverses* the Examiner's restriction requirement and the grouping of the claims into ten (10) "patentably distinct" species as discussed below.

1. There Are No Independent Inventions

Applicant respectfully submits that, in the present application, the species identified by the Examiner are not independent.

In the present application, the disclosed and claimed invention is not directed to different "combinations not capable of use together, having different modes of operation, different functions or different effects." See MPEP §806.04 which recites, by way of example, that an article of apparel such as a shoe is independent from a locomotive bearing, or that a process for painting a house is independent from a process for boring a well.

The present application is directed to an embedded antenna structure which might assume different shapes, such as a square metal pad (claim 5), a slot line (claim 6), a meander line (claim 6), or a patch pattern (claim 6). Moreover, different types of materials that can be used to form the antenna, or the package in which the antenna resides, are disclosed and claimed. For example, the laminate substrate can be an organic laminate substrate (claim 7), or a ceramic laminate substrate (claim 8). Also, the fact that a capacitor can be coupled to the antenna is disclosed and claimed (claims 9 and 10). Applicant respectfully submits that none of these claims is directed to subject matter that can be deemed as independent inventions within the meaning of MPEP §806.04.

MPEP §806.04 also states that when a process and apparatus are claimed and the apparatus cannot be used to practice the process, the inventions are independent. Applicant notes that the present invention contains only “structure” claims and no process claims. Another category of independent inventions mentioned in MPEP §806.04 is when species under a genus are independent from one another. MPEP §806.04 uses the example of a genus of paper clips having species directed to different manners in which the wires in the paper clips are formed in order to achieve a greater increase in the holding power of the paper clips. By way of contrast, the present invention is not directed to different manners for forming an antenna element. All antenna elements according to the invention are formed in the same manner and, as such, there are in fact no process claims. The fact that antenna elements can have different sizes and shapes does not render them functionally different and does not require a different process for forming the

antenna elements. In other words, the different sizes and shapes of the antenna element are simply design choices.

According to MPEP §806.04(e), the species are independent only when there is no relationship between them. In the present application, there is in fact a relationship between all antenna elements of various shapes and sizes, and the only difference is the shapes and sizes which are simply design choices. In other words, the claims of the present invention do not have “mutually exclusive characteristics” as required for a proper restriction requirement under MPEP §806.04(f).

2. There Are No Distinct Inventions

The disclosure and claims in the present application are not directed to distinct species as defined by MPEP §806.05 since, for example, there are no process claims that can be used to achieve a structure different from the claimed structure (there are simply no process claims in the present application). Furthermore, even if applicant were to file divisional applications directed to the ten (10) species identified by the Examiner, “IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.” See MPEP §803.01 (capitals in original).

3. There Is No Serious Burden For Prior Art Search

Furthermore, the MPEP requires that there be a serious burden on the examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02). MPEP §803 emphasizes that: “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Applicant respectfully submits that no additional burden is imposed on the Examiner to conduct a prior art search, since such prior art search need not be directed to a search for different sizes, shapes, and materials used in an antenna or substrate.

4. Applicant’s Express Admission Under MPEP §803

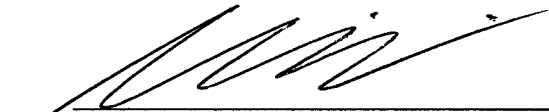
It is noted that **“election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other.”** MPEP §808.01(a) (emphasis in original). In any event, “[i]f there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm’r Pat. 1978).” See MPEP §803. As such, applicant hereby expressly admits that the inventions claimed in claims 1-20 are obvious over each other within the meaning of 35 U.S.C. 103. Due to this express admission alone, the present restriction requirement is traversed and applicant respectfully requests that all claims 1-20 be considered as pending in the present application.

B. Conclusion

In light of the above reasons, applicant respectfully traverses the Examiner's restriction requirement and requests that all claims 1-20 in the present application be Examined as a single application. In the unlikely event that the Examiner maintains the present restriction requirement, and as required by MPEP §809.02(a) and §818.03, applicant has made a provisional election of Species VI (i.e. claims 11-16) in addition to generic claims 1-4 for prosecution in the present application.

Respectfully Submitted,
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claim 11 has been amended as follows:

11. (Once Amended) A structure comprising:

a laminate substrate having a top surface;

a first semiconductor die and a second semiconductor die attached to said top surface of said laminate substrate;

a first antenna element situated on said top surface of said laminate substrate, said first antenna element coupled to a first laminate substrate bond pad;

a second antenna element situated on said top surface of said laminate substrate, said second antenna element coupled to a second laminate substrate bond pad;

a first bonding wire providing an electrical connection between said first laminate substrate bond pad and a semiconductor die bond pad on said first semiconductor die[.];

a second bonding wire providing an electrical connection between said second laminate substrate bond pad and a semiconductor die bond pad on said second semiconductor die.

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